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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,918	01/26/2004	Michael F. Angelo	200314543-1	2632

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

DOAN, DUC T

ART UNIT PAPER NUMBER

2188

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/764,918	Applicant(s) ANGELO ET AL.	
	Examiner Duc T. Doan	Art Unit 2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28, 31 and 32 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-26, 31-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-32 have been presented for examination in this application. In response to the last office action, claims 1,2,4,5,7-8,11-12,14,17-18,21-27,31-32 have been amended, claims 29-30 have been canceled. As the result, claims 1-28,31-32 are now pending in this application.

Claims 27-28 are allowed.

Claims 1-26,31-32 are rejected.

Applicant's arguments filed 7/10/06 have been fully considered but they are not persuasive. Therefore, the rejections from the previous office action are respectfully maintained with changes as needed to address the amendments.

U.S.C. 112, first paragraph

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26,31-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, has possession of the claimed invention.

Independent claims 1,8,14,21,31 have been amended, by adding “computer”. Examiner notes that the specification expressly describe the computer system as having multiple processors with associating programs, such as operating system so that these multiple processors can share files, data by using data communication links, buses etc..(see Specification’s paragraph 2). Specification’s paragraph 20, indicates clients computers and servers representing the computer systems, thus the specification clearly suggests that the phrases “computer system” or “computer” are interchangeable, both representing a system with multiple processors (processors in Fig 3: #102 communicating with other processors by a network, paragraphs 19,26). In fact, paragraph 16 discloses the present invention draws to a method for operating multiple security modules in **a computer system** (see Fig 3: #143, #153); the security modules can be located anywhere in the computer system (see specification’s paragraph 23). Therefore, it’s unclear the differences of “the computer”, as amended, and the “computer system”. Although the “computer system” is disclosed throughout the specification, the computer is not expressly defined in the specification.

All dependent claim(s) are rejected as having the same deficiencies as the claims they depend from.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

A person shall be entitled to a patent unless -

(a) the invention was known or used by other's in this country or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-26,31-32 are rejected under 35 U.S.C. 102 (a) as being anticipated by Challenger (US Pub 2003/0174842).

As in claim 1, Challenger'842 describes a method of operating a first security module in a computer (Challenger'842s Fig 1: #40 TPM server), the method comprising the acts of: detecting a second security module in the computer; determining whether a key associated with the second security module is available to the first security module (Challenger'842's paragraph 28, Fig 3: #54 query whether user's private key is stored on the TCM server, Fig 1: #40 that corresponds to the claim's first security module); and obtaining the key associated with the second security module if the key associated with the second security module is not stored at the first security module (Challenger'842's paragraph 28, server obtains the private key from the client's security module, Fig 1: #54 that corresponds to the claim's second secure module, Fig 1: #22; Challenger's paragraph 12 discloses that the first security module, TCM server Fig 1: #40,

obtaining the private key associating with the second security module, Fig 1: #22, and providing this key information to a client/user. Inherently, if this key has not been stored at the first security module, the first security module, server, will obtain it from the client's computer and save it for future referencing, in a migrating manner, see Fig 4a, paragraph 32).

As in claim 2, the claim recites wherein the first security module is a trusted platform module ("TPM"). Challenger'842's paragraph 26 describes the server TPM Fig 1: # 40 including modules conforming to the trusted platform module specification (see Challenger'842's paragraph 6).

As in claim 3, Challenger'842's paragraph 28 describes comprising the act of requesting the key from the second security module (claim 3; requesting private key from client's system Fig 1: 312).

As in claim 4, the claim recites the act of sending a public key from the first security module to the second security module if the key associated with the second security module is not stored at the first security module. The claim rejected based on the same rationale as of claim 1. Challenger'842's paragraph 28 further discloses when the user's private key is not stored in the first security module (Fig 1: #40 TPM server), the server inherently send the public key (public non-migratable key of the server) to the second security module which being used to "wrap" the private key, and the second security module sends this wrapped information back to the TPM server.

As in claim 5, the claim recites comprising the act of sending a public key along with validation information from the first security module to the second security module if the key associated with the second security module is not stored at the first security module

(Challener'842's paragraph 31 further discloses for both the requesting and responding messages, additional information to validating the messages can be sent along, for example, information associating with authorization for the sender of messages) .

As in claim 6, the claim recites comprising the act of storing the key in a memory associated with the first security module (Challener'842 Fig 1: #48, #50).

As in claim 7, the claim recites comprising the act of defining the key to be a private key (Challener'842's paragraphs 24, 27).

Claims 8,14,21,31 rejected based on the same rationale as in the rejection of claim 1.

Claims 9,15,22,32 rejected based on the same rationale as in the rejection of claim 2.

Claims 10,16,23 rejected based on the same rationale as in the rejection of claim 3.

Claims 11-12,17-18,24-25 rejected based on the same rationale as in the rejection of claims 4-5 respectively.

Claim 19 rejected based on the same rationale as in the rejection of claim 6.

Claims 13,20,26 rejected based on the same rationale as in the rejection of claim 7.

Response to Arguments

Applicant's arguments in response to the last office action has been fully considered but they are not persuasive. Examiner respectfully traverses Applicant's arguments for the following reasons:

As to the remarks on pages 10-14, Applicant argues that the claim 1 as amended, directs to a method for operating multiple secure modules TPM, in a computer. Applicant further directs to specification's paragraph 16 as supporting for "multiple TPMs in a computer". Examiner

respectfully disagrees. Specification's paragraph 16 states "multiple TPMs in a **computer system**", the word "computer" is not mentioned or defined expressly anywhere in the specification, particularly not in the paragraph 16 as indicated in the remark. The computer can be understood broadly as any device capable of processing information to produce a desired result. Thus a processing unit and some memory, for example, specification's Fig 3: #102, processor complex and their memories are computers. Since they have processing units and memories.

The current invention draws to a method of maintaining user/client information such as keys in two security modules, such that this information can be obtained from a backup security module if the other security module is not accessible. In fact, specification's paragraph 23 suggests the locations of the security modules are flexible, they can be anywhere in the computer system complex, as long as clients running on "computers" can access to this information (see Specification's paragraph 23 further suggests that the method works for any number of security modules, for example one per system 100).

In a similar manner, Challenger'842's discloses a method of maintaining user/client information such as keys in two security modules (Challenger'842's Fig 1: #40 TPM server and Fig 1: #22 client's computer), the client can access this information from the server instead of the client's computer (see Challenger's842's paragraph 13). As long as clients can access to this information, either form the client's computer or the backup server, clients can sit at any terminal and accessing the user's private key (Challenger'842's paragraph 12).

Therefore, Challenger'842's clearly anticipates all of claim 1's limitations.

Independent claims 8,14,21,31 are rejected based on the same rationale as above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

When responding to the office action, Applicant is advised to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist examiner to locate the appropriate paragraphs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Doan whose telephone number is 571-272-4171. The examiner can normally be reached on M-F 8:00 AM 05:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on 571-272-4210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


9/8/06
MANO PADMANABHAN
SUPERVISORY PATENT EXAMINER